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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
TAYLOR, JOSHUA D	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/809,630	DANKER, DANIEL	
	Examiner	Art Unit	
	JOSHUA TAYLOR	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 March 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/24/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 15 rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (Pub. No.: US 2002/0042914).

Regarding claim 1, Walker et al. disclose: **A method comprising: receiving a user request to render an on-demand media content** (Paragraph [0027], lines 1-6)**; identifying an advertisement associated with the on-demand media content** (Fig. 2, paragraph [0059], lines 1-10)**; and rendering the advertisement in conjunction with rendering the on-demand media content** (Fig. 4A-4B, paragraph [0064], lines 19-20)**.**

Regarding claim 2, Walker et al. disclose: **The method as recited in claim 1 wherein the on-demand media content comprises video-on-demand available from a server** (Paragraph [0027], lines 1-6)**.**

Regarding claim 3, Walker et al. disclose: **The method as recited in claim 1 wherein the on-demand media content comprises a previously recorded broadcast television program** (Paragraph [0028], lines 1-5)**.**

Regarding claim 15, Walker et al. disclose: **One or more computer-readable media having computer-readable instructions thereon which, when executed by a computer, cause the computer to implement the method as recited in claim 1.** This claim is rejected on the same grounds as claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-6, 16, 18-19, 22-23, 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Pub. No.: US 2002/0042914) in view of Sie et al. (Pub. No.: US 2004/0030599).

Regarding claim 4: The method as recited in claim 1 wherein Walker discloses **receiving advertisement data associated with the broadcast television program that is scheduled to be recorded** (Walker, Fig. 2, paragraph [0059], lines 1-10) and further discloses multiple ways to use viewer information to target advertisements, including characteristics of the show that is currently being watched. However, Walker does not explicitly disclose having an advertisement targeted based on a program that is scheduled to record. Sie discloses that information such as scheduled recordings can be stored in a preference database for use by a transmission system (Sie, paragraph [0049], lines 7-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to target an advertisement based on a program that is scheduled to be recorded. Walker is already using user preferences in order to target advertising, and Sie suggests a scheduled recording as a user preference. Having more user preferences would have been highly desirable in the art, as it would allow the advertisements to be as specific as possible to the user's interests

Regarding claim 5: **The method as recited in claim 4 wherein the advertisement data comprises advertisement video content** (Walker, paragraph [0033], lines 9-13).

Regarding claim 6: **The method as recited in claim 4 wherein the advertisement data comprises an advertisement image** (Walker, paragraph [0033], lines 9-13).

Regarding claim 16: **A system comprising: means for recording a broadcast television program** (Walker, Fig. 1)**; means for transmitting data identifying the broadcast television program to a server system** (Sie, Fig. 1A, paragraph [0049], lines 7-11)**; means for receiving an advertisement associated with the broadcast television program** (Sie, Fig. 1A, paragraph [0049], lines 7-11)**; and means for rendering the advertisement in conjunction with the broadcast television program that is recorded** (Walker, paragraph [0061], lines 14-16)**.** This claim is rejected on the same grounds as claim 4.

Regarding claim 18: **The system as recited in claim 16, implemented as at least one of a cable television system set-top box, a digital video recorder, a digital cable-ready television set, a personal computer, and a satellite television receiver** (Walker, paragraph [0029], lines 2-8)**.**

Regarding claim 19: **A system comprising: a processor; a memory; and an ad targeting application stored in the memory and executed on the processor, the ad targeting application configured to: receive data identifying a broadcast television program scheduled to be recorded on a recording device** (Sie, paragraph [0049], lines 7-11)**; identify an advertisement to be targeted to viewers of the broadcast television program; and cause the advertisement to be transmitted to the recording device** (Walker, Fig. 2, paragraph [0059], lines 1-10)**.** Clearly, a processor, memory, and an ad targeting application are required to implement the system. A processor is inherent in the head end (Walker, paragraph [0037], lines 25-29), and Walker discloses that both the user equipment 66 and the distribution facility 56 may

include sufficient hardware and software capabilities to perform the ad targeting applications (Walker, paragraph [0051], lines 10-15, paragraphs [0052]-[0053]). This claim is rejected on the same grounds as claim 4.

Regarding claim 22: **One or more computer-readable media comprising computer-readable instructions which, when executed, cause a computer system to: receive a user request to record a broadcast television program** (Sie, paragraph [0049], lines 7-11)**; transmit data identifying the broadcast television program to a server system; and receive an advertisement associated with the broadcast television program** (Walker, Fig. 2, paragraph [0059], lines 1-10)**.** This claim is rejected on the same grounds as claim 4.

Regarding claim 23: **The one or more computer-readable media as recited in claim 22, further comprising computer-readable media comprising computer-readable instructions which, when executed, cause a computer system to: record the broadcast television program; receive a user request to view the broadcast television program that was recorded; and render the advertisement in conjunction with rendering the broadcast television program that was recorded** (Walker, paragraph [0061], lines 14-16)**.**

Regarding claim 26: **One or more computer-readable media comprising computer-readable instructions which, when executed, cause a computer system to: receive from a client**

device, data identifying a broadcast television program that is scheduled to be recorded (Sie, paragraph [0049], lines 7-11)**; identify an advertisement to be targeted to viewers of the broadcast television program; and cause the advertisement to be transmitted to the client device** (Walker, Fig. 2, paragraph [0059], lines 1-10)**.** This claim is rejected on the same grounds as claim 4.

Claims 7, 8 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Pub. No.: US 2002/0042914) in view of Sie et al. (Pub. No.: US 2004/0030599) as applied to claim 4 above, and further in view of Paxton et al. (Pub. No.: US 2004/0158858).

Regarding claim 7: The combined teachings of Walker and Sie as a whole do not disclose **wherein the advertisement data comprises advertisement metadata, the metadata comprising business rules associated with an advertisement.** However, Paxton does (paragraph [0086], lines 16-22). Paxton discloses that the advertisements can include identifying information, such as the dates they should be played.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include data comprising business rules associated with an advertisement. This would have been a highly desirable feature, as it would allow the advertisers to choose when their advertisements are to be watched.

Regarding claim 8: **The method as recited in claim 7 wherein the business rules comprise at least one of an indicator of how often the advertisement is to be played, an indicator of which trick modes are to be disabled during the playing of the advertisement, an expiration date associated with the advertisement, a day of the week that the advertisement is to be played, or a time of day at which the advertisement is to be played** (Paxton, paragraph [0086], lines 16-22)**.** This claim is rejected on the same grounds as claim 7.

Regarding claim 24: The combined teachings of Walker and Sie as a whole do not disclose **further comprising computer-readable media comprising computer-readable instructions which, when executed, cause a computer system to select based on a day and/or time, the advertisement from multiple advertisements associated with the broadcast television program.** However, Paxton does (paragraph [0086], lines 16-22). Paxton discloses that the advertisements can include identifying information, such as the dates they should be played.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include data comprising business rules associated with an advertisement. This would have been a highly desirable feature, as it would allow the advertisers to choose when their advertisements are to be watched.

Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Pub. No.: US 2002/0042914) in view of Konig et al. (Pub. No.: US 2005/0149968).

Regarding claim 9, Walker et al. disclose the method as recited in claim 1, however Walker does not disclose **wherein the rendering the advertisement in conjunction with rendering the on-demand media content comprises: rendering the advertisement; and upon completion of the advertisement, rendering the on-demand media content.** Konig, however, discloses that an advertisement may be completed before a video stream is returned to (paragraph [0011], lines 9-11) so that the user is required to watch the full advertisement. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to render the advertisement completely before rendering the on-demand media content, so that the advertisement would reach the user, as would be desired by the paying advertiser.

Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Pub. No.: US 2002/0042914) in view of Paxton et al. (Pub. No.: US 2004/0158858).

Regarding claim 10: **The method as recited in claim 1 wherein the rendering the advertisement in conjunction with rendering the on-demand media content comprises: rendering the on-demand media content; detecting initiation of a pause command before**

the conclusion of the on-demand media content (Paxton, paragraph [0104], lines 1-3); **rendering the advertisement while the on-demand media content is paused.** Walker discloses the method of claim 1, however, Walker does not disclose having an advertisement inserted when a user pauses the on-demand content. Paxton discloses that a commercial can be inserted and played when a user has paused playback of a program as a way to use a time when the user is not watching a program to play an advertisement. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to insert a targeted advertisement when a user pauses on-demand content, and to render the on-demand media content upon detection of termination of the pause command, since having more opportunities to display commercials would have been highly desirable in the art, as it would allow the advertisers more chances to advertise their products.

Claims 11-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Pub. No.: US 2002/0042914) in view of Ozer et al. (Patent No.: US 6,708,335).

Regarding claim 11: **The method as recited in claim 1 further comprising: generating ad tracking data associated with the advertisement** (Ozer, Fig. 4, column 10, lines 18-20); **and transmitting the ad tracking data to a server system** (Ozer, Fig. 4, column 10, lines 61-65). Walker discloses the method of claim 1, however, Walker does not disclose tracking data associated with the advertisement. Ozer discloses tracking viewer behavior of advertisements in

order for advertisers to better understand the effectiveness of their advertising. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to track the add data associated with the targeted advertisements. Being able to give the advertisers more detailed information on how their advertisements are used would have been highly desirable, as it would allow advertisers to more accurately target their advertisements.

Regarding claim 12: **The method as recited in claim 11 wherein the generating comprises recording a date at which the advertisement is played** (Ozer, Fig. 4, column 10, lines 61-65)**.** This claim is rejected on the same grounds as claim 11.

Regarding claim 13: **The method as recited in claim 11 wherein the generating comprises recording a time at which the advertisement is played** (Ozer, Fig. 4, column 10, lines 61-65)**.** This claim is rejected on the same grounds as claim 11.

Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Pub. No.: US 2002/0042914) in view of Ozer et al. (Patent No.: US 6,708,335) as applied to claim 11 above, and further in view of Sie et al. (Pub. No.: US 2004/0030599) and Merriman et al. (Patent No.: US 5,948,061).

Regarding claim 14: The combined teachings of Walker and Ozer as a whole do not disclose **wherein the generating comprises recording an indicator of whether of not a viewer attempted to fast-forward through the advertisement.** However, the combined teaching of Sie and Merriman does. Sie discloses that it may be necessary to prevent a user from fast forwarding through a commercial, as this would mean the advertiser paid for an advertisement that was never seen by the user (Sie, paragraph [0141], lines 1-11). However, Sie does not disclose recording an indication of when this prevention occurs. Merriman discloses that a server can keep track of various user interactions with the advertisements in order to provide advertisers with a better understanding of how to target the display of the advertisements (Merriman, column 7, lines 26-31, column 8, lines 32-37 and 44-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to track and report to the server system when a user tried to fast forward through a commercial. Letting advertisers know when a user had tried to fast forward through a commercial would have been a highly desirable feature in the art, as it would allow advertisers to have a better understanding of how to target the display of the advertisements.

Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Pub. No.: US 2002/0042914) in view of Sie et al. (Pub. No.: US 2004/0030599) as applied to claim 16 above, and further in view of Ozer et al. (Patent No.: US 6,708,335).

Regarding claim 17: The combined teachings of Walker and Sie as a whole do not disclose **further comprising means for transmitting ad tracking data to the server system, the ad tracking data comprising indicators of conditions under which the advertisement was rendered.** However, Ozer does (column 10, lines 18-20, 61-65). Ozer discloses that the date and time that events are performed can be tracked.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to track conditions under which the advertisement was rendered. This would have been a highly desirable feature, as it would allow the advertisers to know when their advertisements were being watched.

Claims 20-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Pub. No.: US 2002/0042914) in view of Sie et al. (Pub. No.: US 2004/0030599) as applied to claim 19 above, and further in view of Ozer et al. (Patent No.: US 6,708,335).

Regarding claim 20: The combined teachings of Walker and Sie as a whole do not disclose **further comprising an ad tracking application stored in the memory and executed on the processor, the ad tracking application configured to receive and store ad tracking data associated with an advertisement that has been rendered in conjunction with on-demand media content.** However, Ozer does (column 10, lines 18-20, 61-65). Ozer discloses that the date and time that events are performed can be tracked.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to track conditions under which the advertisement was rendered. This would have been a highly desirable feature, as it would allow the advertisers to know when their advertisements were being watched.

Regarding claim 21: **The system as recited in claim 20 wherein the ad tracking data identifies a date and time at which the advertisement was played** (Ozer, column 10, lines 61-65)**.** This claim is rejected on the same grounds as claim 20.

Claim 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Pub. No.: US 2002/0042914) in view of Sie et al. (Pub. No.: US 2004/0030599) as applied to claim 23 above, and further in view of Ozer et al. (Patent No.: US 6,708,335).

Regarding claim 25: The combined teachings of Walker and Sie as a whole do not disclose **further comprising computer-readable media comprising computer-readable instructions which, when executed, cause a computer system to: record tracking data that describes conditions associated with the rendering of the advertisement; and transmit the tracking data to the server system.** However, Ozer does (column 10, lines 18-20, 61-65). Ozer discloses that the date and time that events are performed can be tracked.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to track conditions under which the advertisement was rendered. This would have been a highly desirable feature, as it would allow the advertisers to know when their advertisements were being watched.

Claim 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Pub. No.: US 2002/0042914) in view of Sie et al. (Pub. No.: US 2004/0030599) as applied to claim 26 above, and further in view of Ozer et al. (Patent No.: US 6,708,335).

Regarding claim 27: The combined teachings of Walker and Sie as a whole do not disclose **further comprising computer-readable media comprising computer-readable instructions which, when executed, cause a computer system to receive tracking data that describes conditions associated with a rendering of the advertisement.** However, Ozer does (column 10, lines 18-20, 61-65). Ozer discloses that the date and time that events are performed can be tracked.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to track conditions under which the advertisement was rendered. This would have been a highly desirable feature, as it would allow the advertisers to know when their advertisements were being watched.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA TAYLOR whose telephone number is (571)270-3755. The examiner can normally be reached on 8am-5pm, M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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